

JAN 25 2002



UNITED STATES PATENT AND TRADEMARK OFFICE

#12

Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

Birch, Stewart, Kolasch & Birch, LLP  
P.O. Box 747  
Falls Church, VA 22040-0747

In re Application of NEUHAUS et al  
U.S. Application No.: 09/674,768  
Int. Application No.: PCT/EP99/03292  
Int. Filing Date: 12 May 1999  
Priority Date: 13 May 1998  
Attorney Docket No.: 0147-0215P  
For: TRANSGENIC PLANTS WITH A MODIFIED  
ACTIVITY OF A PLASTIDIAL ADP/ATP  
TRANSLOCATOR

DECISION

This is in response to applicants' "Petition Under 37 CFR 1.487(d)" filed 04 January 2002.

**BACKGROUND**

On 12 May 1999, applicants filed international application PCT/EP99/03292, which claimed priority of an earlier Germany application filed 13 May 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 18 November 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 November 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 13 November 2000.

On 06 November 2000, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 16 January 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 23 February 2001, applicants filed an executed declaration.

On 28 March 2001, the DO/EO/US mailed a Notification of a Defective Response (Form PCT/DO/EO/916) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917), which indicated that the declaration filed 23 February 2001 does not identify all of the inventors that are listed on the international application.

On 04 January 2002, applicants filed the present petition under 37 CFR 1.497(d). The petition states that it is accompanied by statements from two individuals who have been deleted as inventors.

### DISCUSSION

A review of the application file indicates that Jozef Schell and Norbert Martini are listed as joint inventors on the international application but are not listed in the declaration filed 23 February 2001.

37 CFR 1.497(d) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

With regard to item (1) above, the requisite statements have been provided.

With regard to item (2) above, the requisite fee has been provided.

With regard to item (3) above, in situations where an assignee consents to a correction of inventorship, ownership of the application must be established. See MPEP 324. Under 37 CFR 3.73(b), ownership is established by documentary evidence of a chain of title from the original owner to the assignee. In the present case, applicants have submitted two assignment agreements. The assignment agreement signed solely by inventor Karl-Heinz Graeve-Kampfenkel is acceptable. The other assignment agreement is improperly executed by inventor Joachim Tjaden and is therefore unacceptable. Additionally, the written statement of the assignee is improper. Specifically, the "Assent of Assignee to Correction and/or Addition of Inventor(s)" states that assignee consents to a change of inventorship from "NEUHAUS, Ekkehard; MOEHLmann, Torsten; GRAEVE-KAMPFENKEL, Karl-Heinz; TJADEN, Joachim" to "NEUHAUS, Ekkehard; MOEHLmann, Torsten; GRAEVE-KAMPFENKEL, Karl-Heinz; TJADEN, Joachim", i.e. no change at all. Therefore, it would be unreasonable to conclude at the present time that the assignee consents to the change of inventorship.

**CONCLUSION**

For the reasons above, the petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)". No additional petition fee is required. Extensions of time are available pursuant to 37 CFR 1.136.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

  
Bryan Tung  
PCT Legal Examiner  
PCT Legal Office

Telephone: 703-308-6614  
Facsimile: 703-308-6459